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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellants	:	Robertson, et al.
Appl. No.	:	10/780,486
Filed	:	February 17, 2004
For	:	NETWORK-BASED PERSONAL CONTACT MANAGER AND ASSOCIATED METHODS
Examiner	:	Romain Jeanty
Group Art Unit	:	3623

**SECOND APPEAL BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
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This Second Appeal Brief is responsive to the Office Action mailed on March 27, 2006 (the "current Office Action"), which the Examiner issued in response to Appellants' original Appeal Brief. By filing this Second Appeal Brief and a Second Notice of Appeal, Appellants are reinstating the original appeal.

In the current Office Action, the Examiner rejects Claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for including the phrase "may have." The Examiner further rejects Claims 1, 10-11, 19 and 37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,049,796 ("Siitonen et al."). The Examiner further rejects Claims 2 and 34-36 under 35 U.S.C. § 103(a) as unpatentable over Siitonen et al. in view of the knowledge of a person of ordinary skill in the art. The Examiner further rejects Claims 3-7, 12-16, and 21 under 35 U.S.C. § 103(a) as unpatentable over Siitonen et al. in view of a PCNetter newsletter article entitled "Special Report: Russell Information Sciences' Calendar Manager." Finally, the Examiner rejects Claims 8, 17-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Siitonen et al. in view of U.S. Patent No. 5,276,901 ("Howell et al.").

Appl. No. : 10/780,486  
Filed : February 17, 2004

### **I. REAL PARTY IN INTEREST**

The real party in interest in the present application is Amazon.com, Inc.

### **II. RELATED APPEALS AND INTERFERENCES**

No related appeals or interferences are pending.

### **III. STATUS OF CLAIMS**

Claims 1-8, 10-21 and 34-37 are currently pending in the application, and are attached hereto as an appendix. Claims 9 and 22-33 are cancelled.

All of the pending claims were finally rejected in the current Office Action and are the subject of this appeal.

### **IV. STATUS OF AMENDMENTS**

No amendments have been made in response to the current Office Action.

### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present application includes two independent claims. Each independent claim is paraphrased below, with citations to corresponding portions of the specification and drawings as required by 37 C.F.R. § 41.37(c)(1)(v). These citations are provided in order to illustrate specific examples and embodiments of the recited claim language, and not to limit or interpret the claims. A citation to a specific paragraph or appendix in the following claim summaries should be treated as a citation to all lines of that paragraph or appendix.

Claim 1 is directed to a network-based personal contact management system (see, e.g., Fig. 5, and page 6, paragraph 30). The system comprises:

- a networked server system (see, e.g., 330 in Fig. 5) that provides a user interface (see, e.g., 380 in Fig. 5, and Figs. 8 and 10) having functionality for users to establish relationships with other users such that each user may have one or more contacts (see, e.g., page 6, ¶ 0030; page 9, ¶ 0042; page 10, ¶ 0046; page 11, ¶ 0049, and page 15, ¶¶ 0069 and 0070);

- a database (see, e.g., 340 in Fig. 5) that stores relationship data indicating the relationships established between the users via the user interface, wherein the relationship data identifies, for each respective user, which other users are contacts of the respective user (see, e.g., page 7, ¶ 0034; page 11, ¶ 0049; and page 14, ¶ 0068); and
- a search module that provides functionality for users to search the database for contacts of their respective contacts, wherein the search module is responsive to performance of a search by a first user by using said relationship data to identify other users that are contacts of contacts of the first user (see, e.g., Fig. 13; page 4, ¶ 0011; page 14, ¶ 0064; pages 22-23, ¶¶ 0094-0097; 343 in Fig. 5; and Appendix G on page 33).

Claim 11 is directed to a computer-implemented method, in a network-based system that provides functionality for users to communicate with other users, for assisting users in locating other users with which to communicate. The method comprises:

- providing a database that stores, for each user of a plurality of users, information about contacts of the respective user (see, e.g., 340 in Fig. 5; page 6, ¶ 0030; page 7, ¶ 0034; page 11, ¶ 0049; and page 14, ¶ 0068);
- receiving, from a first user of said plurality of users, a search request to search for contacts of contacts of the first user (see, e.g., page 14, ¶ 0064; pages 22-23, ¶¶ 0094-0097; and Appendix G on page 33); and
- in response to the search request, searching the database to identify a set of users who are contacts of contacts of the first user, and notifying the first user of the set of users (see, e.g., Fig. 13; page 14, ¶ 0064; page 22-23, ¶¶ 0094-0097, and Appendix G on page 33).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following rejections are to be reviewed on appeal:

1. The rejection of Claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for including the phrase “may have.”
2. The rejection of Claims 1, 10-11, 19 and 37 under 35 U.S.C. § 102(e) as being anticipated by Siitonen et al.
3. The rejection of Claims 2 and 34-36 under 35 U.S.C. § 103(a) as unpatentable over Siitonen et al. in view of the knowledge of a person of ordinary skill in the art.

Appl. No. : 10/780,486  
Filed : February 17, 2004

4. The rejection of Claims 3-7, 12-16, and 21 under 35 U.S.C. § 103(a) as unpatentable over Siitonen et al. in view of the PCNetter newsletter article entitled "Special Report: Russell Information Sciences' Calendar Manager."

5. The rejection of Claims 8, 17-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Siitonen et al. in view of Howell et al.

For purposes of this appeal, Appellants will treat Siitonen et al., Howell et al., and the applied PCNetter newsletter article as prior art. Appellants reserve the right to later disqualify one or more of these references as prior art. Also, by declining to present arguments with respect to some of the dependent claims, Appellants do not imply that the limitations added by such claims are disclosed or suggested by the references.

## **VII. ARGUMENT**

### **A. Rejection Of Claim 1 Under 35 U.S.C. § 112, Second Paragraph, As Being Indefinite For Including The Phrase "May Have"**

For the reasons set forth below, Appellants respectfully submit that the indefiniteness rejection of Claim 1 is improper.

Claim 1 is recited below, with the pertinent language highlighted:

1. A network-based personal contact management system, comprising:
  - a networked server system that provides a user interface having functionality for users to establish relationships with other users such that each user *may have* one or more contacts;
  - a database that stores relationship data indicating the relationships established between the users via the user interface, wherein the relationship data identifies, for each respective user, which other users are contacts of the respective user; and
  - a search module that provides functionality for users to search the database for contacts of their respective contacts, wherein the search module is responsive to performance of a search by a first user by using said relationship data to identify other users that are contacts of contacts of the first user.

**Appl. No.** : 10/780,486  
**Filed** : February 17, 2004

The Examiner asserts that Claim 1 is indefinite “because it is unclear whether the limitations following the phrase [“may have”] are part of the claimed invention.” (Current Office Action at 2.) Appellants respectfully disagree that the phrase “may have” creates any ambiguity that merits rejection under Section 112.

“Whether a claim is invalid for indefiniteness requires a determination whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 U.S.P.Q.2d 1190, 1195 (Fed. Cir. 1993). Furthermore, a claim is indefinite “only if reasonable efforts at claim construction prove futile[.]” *Exxon Research & Engineering Co. v. United States*, 265 F.3d 1371, 1375, 60 U.S.P.Q.2d 1272, 1276 (Fed. Cir. 2001). Under these standards, Claim 1 is not indefinite.

The phrase “may have” is not used in Claim 1 to refer to optional claim limitations, as the Examiner suggests. Rather, the phrase is used to describe the functionality of the user interface that is required by the claim. This same type of language is used in the specification to describe the functionality provided to the user. *See, e.g.*, ¶ 10 (“...each user can create a personal data record, ..., establish contact relationships with other users,...”), ¶ 46 (“...allows a first user to select other users they wish to add...”), ¶ 82 (“If the first user wishes to add contact information..., the first user can do so...”). Accordingly, a person of ordinary skill in the art reading the claim in view of the specification will recognize the language as a reference to the functionality provided by the user interface.

There is no ambiguity that the claim recites a networked server system. There is also no ambiguity that the recited networked server system is required to provide a user interface. There is further no ambiguity that the recited user interface is required to have functionality that allows users to establish relationships with other users, such that each user is afforded the ability to have “one or more contacts.” The phrase “may have” is simply a reference to the fact that users have the option of using (i.e. the ability to use) the recited user interface to create one or more contacts. There is nothing optional or unclear about the requirement that the recited user interface provide that capability to the user.

Furthermore, the language following the phrase “may have” is “one or more contacts.” The concept of “contacts” is important to the invention, and its use in describing the functionality

**Appl. No.** : 10/780,486  
**Filed** : February 17, 2004

of the user interface in the “networked server system” claim limitation is plainly part of the claimed invention. Indeed, the phrase “one or more contacts” provides an antecedent basis for several references to user contacts later in Claim 1 and in dependent claims based off of Claim 1.

Because the language following the phrase “may have” in Claim 1 is part of the claimed invention and helps to describe the claimed invention, and further because there is no ambiguity as to the scope of the claimed invention, Appellants respectfully submit that the indefiniteness rejection of Claim 1 is improper.

**B. Rejection of Claims 1, 10-11, 19 and 37 Under 35 U.S.C. § 102(e) as Being Anticipated By Siitonen et al.**

For the reasons set forth below, Appellants respectfully submit that the anticipation rejections of Claims 1, 10-11, 19 and 37 are improper.

**1. Independent Claim 1**

Siitonen et al. does not disclose a network-based personal contact management system, comprising:

a networked server system that provides a user interface having functionality for users to establish relationships with other users such that each user may have one or more contacts;

a database that stores relationship data indicating the relationships established between the users via the user interface, wherein the relationship data identifies, for each respective user, which other users are contacts of the respective user; and

a search module that provides functionality for users to search the database for contacts of their respective contacts, wherein the search module is responsive to performance of a search by a first user by using said relationship data to identify other users that are contacts of contacts of the first user.

Siitonen et al. teaches a search module that identifies contacts within a database either by scrolling through a list with arrow keys (*see* Siitonen et al. at Fig. 4A (element 2) and Figs. 6A and 6B) or through text-matching a character string in a search query with text associated with a contact (e.g., the contact name) (*id.* at col. 5, line 61 – col. 6, line 41; Figs. 4A, 4B, 7A and 7B). The contact database of Siitonen et al. includes information on “names, addresses, phone numbers, E-mail addresses, and telefax calling numbers.” (*Id.* at col. 4, line 54-56.) Through use

Appl. No. : 10/780,486  
Filed : February 17, 2004

of the arrow keys and search engine, Siitonen et al. discloses a search module that allows a user to search the database containing information on his or her own contacts. (*Id.* at col. 5, line 61 – col. 6, line 41; Figs. 4A, 4B.)

In contrast, the search module of Siitonen et al. does not provide functionality for users to search a database for *contacts of their respective contacts*. Nor is the search module of Siitonen et al. responsive to performance of a search by a first user by using relationship data to identify other users that are contacts of contacts of the first user. Indeed, the search module of Siitonen et al. does not identify for a user “contacts of contacts” of that user. Only the user’s own contacts are searched. As such, there is no disclosure of a search module with the functionality required by the recited search module of Claim 1.

Because Siitonen et al. does not disclose each limitation of Claim 1, the anticipation rejection of Claim 1 is improper and should be withdrawn.

**2. Dependent Claim 10**

Claim 10 depends directly from Claim 1, and is allowable for at least the same reasons as set forth above for Claim 1.

**3. Independent Claim 11**

Claim 11 recites as follows:

11. In a network-based system that provides functionality for users to communicate with other users, a computer-implemented method for assisting users in locating other users with which to communicate, the method comprising:  
providing a database that stores, for each user of a plurality of users, information about contacts of the respective user;  
receiving, from a first user of said plurality of users, a search request to search for contacts of contacts of the first user; and  
in response to the search request, searching the database to identify a set of users who are contacts of contacts of the first user, and notifying the first user of the set of users.

As discussed above, Siitonen et al. does not disclose the ability to search its database to identify a set of users “who are contacts of contacts of the first user.” Also as discussed above, Siitonen et al. does not disclose the ability to notify the user of a set of users “who are contacts of contacts of the first user.” Instead, Siitonen et al. teaches the use of arrow keys and a text string-

**Appl. No.** : 10/780,486  
**Filed** : February 17, 2004

based search engine that allows a user to search a database containing information on the user's own contacts. (*Id.* at col. 5, line 61 – col. 6, line 41; Figs. 4A, 4B.)

The Examiner asserts that Siitonen et al. discloses at col. 10, lines 21-27 “notifying the first user of the set of users” who are contacts of contacts. (*See* Current Office Action at 4.) To the contrary, the passage cited by the Examiner discusses enabling the making of a telephone call by the telephone portion of the integrated PDA/telephone apparatus using a telephone number found through a search of the database of the PDA portion of the apparatus. There is no simply no teaching of identifying for the user a set of users who are contacts of contacts. (*See* Siitonen et al. at col. 10, lines 21-27.)

For the above reasons, Appellants submit that the anticipation rejection of Claim 11 is improper.

**4. Dependent Claim 19**

Claim 19 depends directly from Claim 11, and thus the anticipation rejection of Claim 19 is improper for the same reasons provided above for Claim 11. Claim 19 also includes additional limitations not found in Siitonen et al. Specifically, Claim 19 adds the following limitations to Claim 11: “wherein notifying the first user of the set of users comprises displaying an indication of how each user in the set is related to the first user.” Siitonen et al. does not disclose a system with multiple discrete users, and likewise has no concept of relationships between users. As such, the apparatus of Siitonen et al. does not notify the user “of how each user in the set is related to the first user.”

The Examiner asserts that this limitations added by Claim 19 are disclosed by Siitonen et al. at col. 3, lines 1-17. (*See* Current Office Action at 4.) However, Appellants respectfully submit that the closest teaching to the limitation in question is that the Siitonen et al. apparatus includes “a display for showing the directory of those records that compare to the search key.” (*See* Siitonen et al. at col. 3, lines 7-9.) Notably, nowhere in the cited passage, or elsewhere in Siitonen et al., is it taught to display an indication of how each user in a set of contacts of contacts is related to the first user.

For the above reasons, Appellants submit that the anticipation rejection of Claim 19 is improper.



Appl. No. : 10/780,486  
Filed : February 17, 2004

**5. Dependent Claim 37**

Claim 37 depends directly from Claim 1, and thus the anticipation rejection of Claim 37 is improper for the same reasons provided above for Claim 1. Claim 37 also includes additional limitations not found in Siitonen et al. Specifically, Claim 37 adds the following limitations: “wherein the search module is additionally responsive to performance of the search by notifying the first user how an identified contact of a contact of the first user is related to the first user.” As discussed above, Siitonen et al. does not contemplate the concept of a “contact of a contact” of the user. As such, the search module of Siitonen et al. is incapable of notifying the user of how an identified contact of a contact of the user is related to the user.

For the above reasons, Appellants submit that the anticipation rejection of Claim 37 is improper.

**C. Rejection of Claims 2 and 34-36 Under 35 U.S.C. § 103(a) as Unpatentable Over Siitonen et al. In View Of The Knowledge of a Person of Ordinary Skill in the Art**

For the reasons set forth below, Appellants respectfully submit that the obviousness rejections of Claims 2 and 34-36 are improper.

**1. Dependent Claim 2**

Claim 2 depends directly from Claim 1, and adds the following limitations:

wherein the database additionally includes personal data records of the users, and the relationship data specifies permission levels granted by each respective user for allowing specific contacts of the respective user to view information from the personal data record of the respective user, and the server system controls access to the personal data records according to said permission levels.

The Examiner asserts that Claim 2 is invalid for obviousness in view of Siitonen et al. (See Current Office Action at 5.) The Examiner concedes that Siitonen et al. does not disclose relationship data that specifies permission levels granted by different users for allowing specific contacts of respective users to view information from the personal data records of the respective users. (*Id.*) However, the Examiner asserts that “most databases contain permission level [sic] for different users for allowing users to view only users’ permitted information” and that incorporating this feature into Siitonen “would have been obvious to a person of ordinary skill in the art.” (*Id.*) Appellants respectfully disagree for at least two reasons.

Appl. No. : 10/780,486  
Filed : February 17, 2004

incorporating this feature into Siitonen “would have been obvious to a person of ordinary skill in the art.” (*Id.*) Appellants respectfully disagree for at least two reasons.

First, the Examiner disregards the details of the claim limitations in assessing the knowledge of a person of ordinary skill in the art. Claim 2 does not merely incorporate permission levels in a manner well known in the art of databases. Rather, it recites “wherein the database additionally includes personal data records of the users, and the relationship data specifies permission levels granted by each respective user for allowing specific contacts of the respective user to view information from the personal data record of the respective user, and the server system controls access to the personal data records according to said permission levels.” The Examiner has not made a showing that it would have been obvious to a person of ordinary skill in the art to incorporate all of the limitations of the recited system of Claim 2.

Second, the Examiner fails to provide any motivation or suggestion for modifying Siitonen et al. to incorporate different permission levels on a user-by-user basis. Siitonen et al. is designed to work with a single user. As such, there would appear to be no reason to modify the single-user Siitonen et al. system to incorporate a permission arrangement that would provide different treatments for different users.

For the above reasons, Appellants submit that the rejection of Claim 2 is improper.

**2. Dependent Claims 34 and 35**

Claims 34 and 35 depend directly from Claim 11, and are allowable for at least the same reasons as set forth above for Claim 11.

**3. Dependent Claim 36**

Claim 36 depends directly from Claim 1, and is allowable for at least the same reasons set forth above for Claim 1.

**D. Rejection Of Claims 3-7, 12-16 and 21 Under 35 U.S.C. § 103(a) as Unpatentable Over Siitonen et al. in View of The PCnetter Newsletter Article Entitled “Special Report: Russell Information Sciences’ Calendar Manager”**

For the reasons set forth below, Appellants respectfully submit that the obviousness rejections of Claims 3-7, 12-16 and 21 are improper.

**Appl. No.** : 10/780,486  
**Filed** : February 17, 2004

**1. Dependent Claim 3**

Claim 3 depends from Claim 1, and is allowable for at least the same reasons as set forth above for Claim 1.

**2. Dependent Claims 4-6**

The Examiner asserts that Claim 4 is unpatentable over Siitonen et al. in view of an electronic article describing the Russell Information Sciences' Calendar Manager ("Russell Calendar Manager"). (*See* Current Office Action at 5-6.) Appellants respectfully disagree.

Claim 4 depends directly from Claim 1, and the combination of Siitonen et al. and the Russell Calendar Manager does not disclose or suggest each of the limitations of Claim 1. Claim 4 also includes additional limitations not found in the recited references. Specifically, Claim 4 adds the following limitations to Claim 1: "wherein the relationship data specifies permission levels granted by users for sharing information with other users, and the search module searches for contacts of contacts in accordance with the permission levels." Neither Siitonen et al. nor the Russell Calendar Manager provides the ability to search for contacts of contacts in accordance with permission levels set by users.

Appellants also respectfully submit that the Examiner has not identified a suggestion or motivation to combine Siitonen et al. with the Russell Calendar Manager.

For the above reasons, Appellants submit that the rejection of Claim 4 is improper.

Claims 5 and 6 depend directly from Claim 4, and are allowable for at least the reasons set forth above for Claim 4.

**3. Dependent Claim 7**

Claim 7 depends directly from Claim 1, and the combination of Siitonen et al. and the Russell Calendar Manager does not disclose or suggest each of the limitations of Claim 1. Accordingly, the rejection of Claim 7 based on those references is improper.

Claim 7 also includes additional limitations not found in the recited references. Specifically, Claim 7 adds the following limitations to Claim 1: "wherein the search module provides functionality for the first user to search the database for contacts of contacts of the first user that reside in a common geographic region with the first user." The Examiner concedes that Siitonen et al. does not provide the ability to search for contacts of contacts on the basis of geography. The Examiner also does not assert that the Russell Calendar Manager provides such

**Appl. No.** : 10/780,486  
**Filed** : February 17, 2004

a teaching. Instead, the Examiner asserts that “it would have been obvious to a person of ordinary skill in the art to incorporate this feature into the Siitonen’s system with the motivation to allow a user to contact a user in the same area.” (*See* Current Office Action at 6.) This assertion is wholly unsupported and appears to be pure hindsight based on Appellants’ teaching.

To the extent that the Examiner is relying upon the combination of Siitonen et al. and the Russell Calendar Manager to find Claim 7 unpatentable, Appellants also respectfully submit that the Examiner has not identified a suggestion or motivation to combine Siitonen et al. with the Russell Calendar Manager.

For the above reasons, Appellants submit that the rejection of Claim 7 is improper.

**4. Dependent Claim 12**

Claim 12 depends directly from Claim 11, and the combination of Siitonen et al. and the Russell Calendar Manager does not disclose or suggest each of the limitations of Claim 11. Accordingly, the rejection of Claim 12 based on those two references is improper.

Claim 12 also includes additional limitations not found in the recited references. For example, Claim 12 adds the following limitations to Claim 11: “wherein searching the database comprises taking into consideration permissions granted by the users such that a second user who is a contact of a contact of the first user will not be exposed to the first user unless the second user has granted permission to allow such exposure.”

The Examiner concedes that Siitonen et al. does not provide these limitations. The Examiner also fails to assert that the Russell Calendar Manager provides these limitations. Instead, the Examiner asserts that “it would have been obvious to a person of ordinary skill in the art to incorporate these features into the disclosures of Siitonen with the motivation to prevent unauthorized users from viewing other users’ information.” (*See* Current Office Action at 6.) Appellants respectfully disagree. This assertion is wholly unsupported and appears to be pure hindsight based on Appellants’ teaching. Appellants respectfully submit that the cited art, alone or in combination, fail to teach or suggest the limitations recited in Claim 12.

For the above reasons, Appellants submit that the rejection of Claim 12 is improper.

Appl. No. : 10/780,486  
Filed : February 17, 2004

**5. Dependent Claim 13**

Claim 13 depends directly from Claim 11, and the combination of Siitonen et al. and the Russell Calendar Manager does not disclose or suggest each of the limitations of Claim 11. Accordingly, the rejection of Claim 13 based on those two references is improper.

Claim 13 also includes additional limitations not found in the recited references. For example, Claim 13 adds the following limitations to Claim 11: “wherein searching the database comprises taking into consideration permissions granted by the users such that a second user who is a contact of a contact of the first user will not be exposed to the first user unless the second user has granted permission to allow such exposure.”

The Examiner concedes that Siitonen et al. does not provide these limitations. The Examiner also fails to assert that the Russell Calendar Manager provides these limitations. Instead, the Examiner asserts that “it would have been obvious to a person of ordinary skill in the art to incorporate these features into the disclosures of Siitonen with the motivation to prevent unauthorized users from viewing other users’ information.” (See Current Office Action at 6.) Appellants respectfully disagree. This assertion is wholly unsupported and appears to be pure hindsight based on Appellants’ teaching.

Appellants also respectfully repeat that the Examiner has not identified a suggestion or motivation to combine Siitonen et al. with the Russell Calendar Manager.

For the above reasons, Appellants submit that the rejection of Claim 13 is improper.

**6. Dependent Claim 14**

Claim 14 depends directly from Claim 11, and the combination of Siitonen et al. and the Russell Calendar Manager does not disclose or suggest each of the limitations of Claim 11. Accordingly, the rejection of Claim 14 based on those two references is improper.

Claim 14 also includes additional limitations not found in the recited references. For example, Claim 14 adds the following limitations to Claim 11: “wherein searching the database comprises taking into consideration permissions granted by the users such that contacts of a second user who is a contact of the first user are not searched unless the second user has granted permission to the first user to search for contacts of the second user.”

The Examiner concedes that Siitonen et al. does not provide these limitations. The Examiner also fails to assert that the Russell Calendar Manager provides these limitations.

**Appl. No.** : **10/780,486**  
**Filed** : **February 17, 2004**

Instead, the Examiner asserts that “it would have been obvious to a person of ordinary skill in the art to incorporate these features into the disclosures of Siitonen with the motivation to prevent unauthorized users from viewing other users’ information.” (See Current Office Action at 6.) Appellants respectfully disagree. This assertion is wholly unsupported and appears to be pure hindsight based on Appellants’ teaching.

Appellants also respectfully repeat that the Examiner has not identified a suggestion or motivation to combine Siitonen et al. with the Russell Calendar Manager.

For the above reasons, Appellants submit that the rejection of Claim 14 is improper.

**7. Dependent Claim 15**

Claim 15 depends directly from Claim 11, and the combination of Siitonen et al. and the Russell Calendar Manager does not disclose or suggest each of the limitations of Claim 11. Accordingly, the rejection of Claim 15 based on those two references is improper.

Claim 15 also includes additional limitations not found in the recited references. For example, Claim 15 adds the following limitations to Claim 11: “wherein searching the database additionally comprises excluding a set of contacts of a second user who is a contact of the first user if the second user has not granted permission to the first user to search the second user’s contacts.”

The Examiner concedes that Siitonen et al. does not provide these limitations. The Examiner also fails to assert that the Russell Calendar Manager provides these limitations. Instead, the Examiner asserts that “it would have been obvious to a person of ordinary skill in the art to incorporate these features into the disclosures of Siitonen with the motivation to prevent unauthorized users from viewing other users’ information.” (See Current Office Action at 6.) Appellants respectfully disagree. This assertion is wholly unsupported and appears to be pure hindsight based on Appellants’ teaching.

For the above reasons, Appellants submit that the rejection of Claim 15 is improper.

**8. Dependent Claim 16**

The Examiner asserts that Claim 16 is unpatentable over Siitonen et al. in view of the Russell Calendar Manager. (See Current Office Action at 6.) Appellants respectfully disagree.

**Appl. No.** : 10/780,486  
**Filed** : February 17, 2004

database comprises taking residence information of the users into consideration to search for users who both (a) are contacts of contacts of the first user, and (b) reside in a common geographic region with the first user.” The Examiner concedes that Siitonen et al. does not provide the ability to search for contacts of contacts on the basis of geography. The Examiner also does not assert that the Russell Calendar Manager provides these limitations. Instead, as with Claim 7, the Examiner asserts that it would have been obvious to a person of ordinary skill in the art to incorporate this feature into the Siitonen et al. system “with the motivation to allow a user to contact a user in the same area.” (See Current Office Action at 6.) As with Claim 7, this assertion is wholly unsupported and appears to be pure hindsight based on Appellants’ teaching.

For the above reasons, Appellants submit that the rejection of Claim 16 is improper.

**9. Dependent Claim 21**

Claim 21 depends directly from Claim 11, and the combination of Siitonen et al. and the Russell Calendar Manager does not disclose or suggest each of the limitations of Claim 11. Accordingly, the rejection of Claim 21 based on those references is improper.

**E. Rejection of Claims 8, 17-18, and 20 Under 35 U.S.C. § 103(a) as Unpatentable Over Siitonen et al. In View of Howell et al.**

**1. Dependent Claim 8**

The Examiner asserts that Claim 8 is unpatentable over Siitonen et al. in view of Howell et al. (See Current Office Action at 7.) Appellants respectfully disagree.

Claim 8 depends directly from Claim 1, and the combination of Siitonen et al. and Howell et al. does not disclose or suggest each of the limitations of Claim 1. Accordingly, the rejection of Claim 8 based on that combination is improper.

Claim 8 also includes additional limitations not found in the recited references. Specifically, Claim 8 adds the following limitations: “wherein the search module provides functionality for the first user to search the database for contacts of contacts of the first user that are affiliated with a group with which the first user is also affiliated.” The Examiner concedes that Siitonen et al. does not provide the ability to search for contacts of contacts that are affiliated with a particular group. The Examiner asserts that Howell et al. makes this teaching. Appellants respectfully disagree.

**Appl. No.** : 10/780,486  
**Filed** : February 17, 2004

functionality for the first user to search the database for contacts of contacts of the first user that are affiliated with a group with which the first user is also affiliated.” The Examiner concedes that Siitonen et al. does not provide the ability to search for contacts of contacts that are affiliated with a particular group. The Examiner asserts that Howell et al. makes this teaching. Appellants respectfully disagree.

Howell et al. discloses a method and data processing system for controlling access to documents stored in an electronic library. One criterion examined by the Howell et al. system to determine whether to grant a particular user access to a particular document is to assess whether the user is affiliated with a designated group that is allowed access to that document. (*See, e.g.,* Howell et al. at col. 2, lines 18 – 33.) Howell et al. does not disclose the ability for users to search for other users based on their affiliation with a designated group. Indeed, the Howell et al. system does not provide the ability for users to search for other users. Thus Howell et al. does not disclose the added limitations of Claim 8.

Appellants also respectfully submit that the Examiner has not identified a suggestion or motivation to combine Siitonen et al. with Howell et al. The two patents address entirely different problems with no apparent overlap. This does not support a motivation to combine.

For the above reasons, Appellants submit that the rejection of Claim 8 is improper.

## **2. Dependent Claim 17**

Claim 17 depends directly from Claim 11, and the combination of Siitonen et al. and Howell et al. does not disclose or suggest each of the limitations of Claim 11. Accordingly, the rejection of Claim 17 based on that combination is improper.

Claim 17 also includes additional limitations not found in these two references. Specifically, Claim 17 adds the following limitations to Claim 11: “wherein searching the database comprises taking group affiliation data of the users into consideration to search for users who both (a) are contacts of contacts of the first user, and (b) are affiliated with a group with which the first user is also affiliated.” The Examiner concedes that Siitonen et al. does not provide the ability to search for contacts of contacts that are affiliated with a particular group. The Examiner asserts that Howell et al. makes this teaching. However, as discussed above in connection with Claim 8, Howell et al. does not disclose the ability for users to search for other users based on their affiliation with a designated group. Indeed, the Howell et al. system does



**Appl. No.** : **10/780,486**  
**Filed** : **February 17, 2004**

not provide the ability for users to search for other users. Thus Howell et al. does not disclose the added limitations of Claim 17.

For the above reasons, Appellants submit that the rejection of Claim 17 is improper.

**3. Dependent Claim 18**

Claim 18 depends directly from Claim 11, and the combination of Siitonen et al. and Howell et al. does not disclose or suggest each of the limitations of Claim 11. Accordingly, the rejection of Claim 18 based on that combination is improper.

Claim 18 also includes additional limitations not found in these two references. Specifically, Claim 18 adds the following limitations to Claim 11: “wherein notifying the first user of the set of users comprises informing the first user that a user in said set is affiliated with a group with which the first user is also affiliated.” The Examiner concedes that Siitonen et al. does not provide the ability to inform the user that another user is affiliated with a particular group. The Examiner asserts that Howell et al. makes this teaching. Applicant respectfully disagrees. Howell et al. does not inform a user conducting a search that another user found in the search is affiliated with the same group as the first user. Indeed, Howell et al. does not inform users of the identity of other users affiliated with a group. Furthermore, as discussed above, the Howell et al. system does not provide the ability for users to search for other users. Thus Howell et al. does not disclose the added limitations of Claim 18. Appellants also respectfully repeat that the Examiner has not identified a suggestion or motivation to combine Siitonen et al. with Howell et al.

For the above reasons, Appellants submit that the rejection of Claim 18 is improper.

**4. Dependent Claim 20**

Claim 20 depends directly from Claim 11, and the combination of Siitonen et al. and Howell et al. does not disclose or suggest each of the limitations of Claim 11. Accordingly, the rejection of Claim 20 based on that combination is improper.

Claim 20 also includes additional limitations not found in the recited references. Specifically, Claim 20 adds the following limitations to Claim 11: “further comprising providing to the first user an option to add a user from said set of users to a personal address book of the first user.” The Examiner concedes that Siitonen et al. does not provide the ability to add a user found from a search to a personal address book, and the Examiner fails to point out this teaching

Appl. No. : 10/780,486  
Filed : February 17, 2004

in Howell et al. Instead, the Examiner asserts that "allowing a user an option to add other user to address book is well known in the art." (See Current Office Action at 7.) Claim 20 does not simply allow a user to add a contact to his or her address book – Claim 20 allows a user to add to his or her personal address book a contact *found through a search of contacts of contacts*. Accordingly, the Examiner's assertion is wholly unsupported and appears to be pure hindsight based on Appellants' teaching.

To the extent that the Examiner is relying upon the combination of Siitonen et al. and Howell et al. to find Claim 20 unpatentable, Appellants also respectfully submit that the Examiner has not identified a suggestion or motivation to combine Siitonen et al. with Howell et al.

For the above reasons, Appellants submit that the rejection of Claim 20 is improper.

#### **VIII. CONCLUSION**

For the reasons set forth above, the rejections of Claims 1-8, 10-21 and 34-37 are improper and should be reversed.

Respectfully submitted,

Knobbe, Martens, Olson & Bear, LLP

Dated: July 7, 2006

By: 

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**CLAIMS APPENDIX**

1. A network-based personal contact management system, comprising:
  - a networked server system that provides a user interface having functionality for users to establish relationships with other users such that each user may have one or more contacts;
  - a database that stores relationship data indicating the relationships established between the users via the user interface, wherein the relationship data identifies, for each respective user, which other users are contacts of the respective user; and
  - a search module that provides functionality for users to search the database for contacts of their respective contacts, wherein the search module is responsive to performance of a search by a first user by using said relationship data to identify other users that are contacts of contacts of the first user.
2. The system of Claim 1, wherein the database additionally includes personal data records of the users, and the relationship data specifies permission levels granted by each respective user for allowing specific contacts of the respective user to view information from the personal data record of the respective user, and the server system controls access to the personal data records according to said permission levels.
3. The system of Claim 2, wherein the user interface includes a personal address book interface through which each user can view information about his or her respective contacts in accordance with the permission levels.
4. The system of Claim 1, wherein the relationship data specifies permission levels granted by users for sharing information with other users, and the search module searches for contacts of contacts in accordance with the permission levels.
5. The system of Claim 4, wherein the permission levels indicate, for each respective contact of the first user, whether the first user is authorized to search for contacts of the respective contact.
6. The system of Claim 4, wherein the permission levels indicate, for at least a second user who is a contact of the first user, whether the first user is permitted to search for contacts of the second user.

7. The system of Claim 1, wherein the search module provides functionality for the first user to search the database for contacts of contacts of the first user that reside in a common geographic region with the first user.

8. The system of Claim 1, wherein the search module provides functionality for the first user to search the database for contacts of contacts of the first user that are affiliated with a group with which the first user is also affiliated.

9. (canceled)

10. The system of Claim 1, wherein the search module runs on the server system and is accessed by the users via the user interface.

11. In a network-based system that provides functionality for users to communicate with other users, a computer-implemented method for assisting users in locating other users with which to communicate, the method comprising:

providing a database that stores, for each user of a plurality of users, information about contacts of the respective user;

receiving, from a first user of said plurality of users, a search request to search for contacts of contacts of the first user; and

in response to the search request, searching the database to identify a set of users who are contacts of contacts of the first user, and notifying the first user of the set of users.

12. The method of Claim 11, wherein searching the database comprises taking into consideration permissions granted by the users such that a second user who is a contact of a contact of the first user will not be exposed to the first user unless the second user has granted permission to allow such exposure.

13. The method of Claim 11, wherein searching the database comprises taking into consideration permissions granted by the users such that a second user, who is a contact of a third user who is a contact of the first user, will not be exposed to the first user unless both the second user and the third user have granted permissions that authorize such exposure.

14. The method of Claim 11, wherein searching the database comprises taking into consideration permissions granted by the users such that contacts of a second user who is a

**Appl. No.** : 10/780,486  
**Filed** : February 17, 2004

contact of the first user are not searched unless the second user has granted permission to the first user to search for contacts of the second user.

15. The method of Claim 11, wherein searching the database additionally comprises excluding a set of contacts of a second user who is a contact of the first user if the second user has not granted permission to the first user to search the second user's contacts.

16. The method of Claim 11, wherein searching the database comprises taking residence information of the users into consideration to search for users who both (a) are contacts of contacts of the first user, and (b) reside in a common geographic region with the first user.

17. The method of Claim 11, wherein searching the database comprises taking group affiliation data of the users into consideration to search for users who both (a) are contacts of contacts of the first user, and (b) are affiliated with a group with which the first user is also affiliated.

18. The method of Claim 11, wherein notifying the first user of the set of users comprises informing the first user that a user in said set is affiliated with a group with which the first user is also affiliated.

19. The method of Claim 11, wherein notifying the first user of the set of users comprises displaying an indication of how each user in the set is related to the first user.

20. The method of Claim 11, further comprising providing to the first user an option to add a user from said set of users to a personal address book of the first user.

21. The method of Claim 11, wherein the database additionally stores personal data records of the users, and permissions granted by the users for exposing information from their respective personal data records to other users, and the method further comprises providing user access to the personal data records in accordance with the permissions.

22-33: (canceled)

34. The method of Claim 11, wherein searching the database comprises joining tables of said database to identify users who are contacts of contacts of the first user.

35. The method of Claim 11, wherein notifying the first user of the set of users comprises generating a display that identifies, for a second user who is a member of the set, an intervening user who serves as a link between the first and second users.

**Appl. No.** : **10/780,486**  
**Filed** : **February 17, 2004**

36. The system of Claim 1, wherein the search module identifies said other users that are contacts of contacts of the first user, at least in part, by performing a database join operation to join tables of said database.

37. The system of Claim 1, wherein the search module is additionally responsive to performance of the search by notifying the first user how an identified contact of a contact of the first user is related to the first user.

**Appl. No.** : **10/780,486**  
**Filed** : **February 17, 2004**

**EVIDENCE APPENDIX**

None

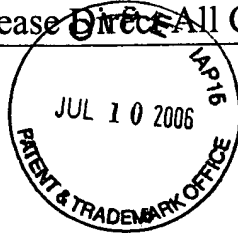
**RELATED PROCEEDINGS APPENDIX**

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## TRANSMITTAL LETTER

## SECOND APPEAL BRIEF

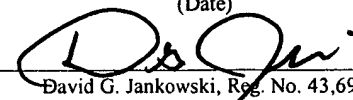
Applicant : Robertson, et al.  
App. No : 10/780,486  
Filed : February 17, 2004  
For : NETWORK-BASED PERSONAL  
CONTACT MANAGER AND  
ASSOCIATED METHODS  
Examiner : Romain Jeanty  
Art Unit : 3623

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Dated: July 7, 2006



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